



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,396	01/18/2001	J. Gregor Sutcliffe	22908-0002D1	7291

20350 7590 03/31/2003

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

HAYES, ROBERT CLINTON

ART UNIT	PAPER NUMBER
----------	--------------

1647

DATE MAILED: 03/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,396

Applicant(s)

Sutcliffe et al

Examiner

Robert C. Hayes, Ph.D.

Art Unit

1647



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 6, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-19 is/are pending in the application.
- 4a) Of the above, claim(s) 3-7 and 10-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 3-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

Art Unit: 1647

DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of Group IV (claims 8-9) in Paper No. 10 is acknowledged.

Claims 3-7 & 10-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions, the requirement having been traversed in Paper No. 10.

However, because each of the sequences in cancelled base claim 1 are unique, as exemplified by their unique SEQ ID NOs, which therefore define unique epitopes, further restriction is necessitated because the non-coextensiveness of the search and examination for each group would constitute an undue burden on the examiner to search and consider all the separable groups.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- IVa. Claims 8-9, drawn to antibodies to rat cortistatin of SEQ ID NOs: 2, 6-7, 8(?) & 9, classified in Class 530, subclass 387.1. Note page 95 of the specification will need to be corrected, in order to be in compliance with the SEQUENCE RULES for SEQ ID NO:8, which is listed as both a rat and murine sequence.
- IVb. Claims 8-9, drawn to antibodies to mouse cortistatin of SEQ ID NOs: 5, 10-11 & 12, classified in Class 530, subclass 387.1.

Art Unit: 1647

IVc. Claims 8-9, drawn to antibodies to human cortistatin of SEQ ID No: 23-24(?) & 26, classified in Class 530, subclass 387.1. Note that the specification will need to be amended to indicate what SEQ ID NOs: 22-23 exactly represent, in order to be in compliance with the SEQUENCE RULES.

3. The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relation of Inventions" in MPEP 806.05 for inventive groups that are directed to different products, restriction is deemed proper because these products appear to constitute patently distinct inventions for the following reason:

Groups IVa-IVc are directed to products that are physically and functionally distinct, as illustrated by the unique species SEQ ID NOs, which constitute the distinctive epitopes that otherwise define these distinct antibodies. It is pointed out that there is a proper distinction between these groups, since each product is not required in order for the other to exist. Thereby, these groups are distinct and separable for the reasons stated, and restriction for examination purposes as indicated is proper.

4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed. Additionally, in order to be fully responsive to this restriction requirement the claims will need to be amended

Art Unit: 1647

to separate murine, rat and human claims. Note that the specification is also required to be amended on page 95, etc. (i.e., as it relates to SEQ ID NO:8), and wherever SEQ ID NOs: 22-23 are described.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(I).


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (703) 305-3132. The examiner can normally be reached on Monday through Thursday, and alternate Fridays, from 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 305-4623. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Robert C. Hayes, Ph.D.
March 26, 2003



GARY KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600